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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,792	03/30/2000	Vincenzo Scotto Di Carlo	GR 97 P 2659	7892

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EXAMINER

PHAN, JOSEPH T

ART UNIT PAPER NUMBER

2645

DATE MAILED: 07/23/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/538,792

Applicant(s)

DI CARLO ET AL.

Examiner

Joseph T Phan

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, "the message" as claimed in line 11 and "the new message as claimed in line 13 is indefinite as to which message from the plurality of messages applicant is referring to, Line 2 recites "a message", Line 5 recites "a new message", and Line 12 recites "a new message". The specification teaches several different types of messages (e.g. notification message, message header, caller ID message, text message, spoken voicemail message, etc.), therefore by not establishing antecedent basis, the claim is indefinite. More specifically, applicant needs to clarify the newly added limitation of "in contrast to transmitting the message" as this could be read as just part of the original message. Appropriate correction is required.

Furthermore, "the subscriber" in line 7 lacks antecedent basis from "a subscriber" in line 1 and in line 6. Appropriate clarification or correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2645

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**3. Claims 1-12 rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al., Patent #6,333,973.**

Regarding claim 1, Smith teaches a method of notifying a subscriber of a plurality of message services of a message, which comprises:

indicating, with each of the plurality of message services, to a common notification server a presence of a new message for a subscriber on the respective message service (Fig. 7A/7B and col. 3 lines 50-54);

selecting, by the subscriber, at least one terminal from a plurality of terminals of the message services (*Fig. 7A/7B, Fig. 11; a plurality of terminals of messages services is shown on the phone*); and transmitting a notification, with the notification server, to the least one selected terminal, in contrast to transmitting the message, the transmitted notification indicating that a new message is present and in which message service the new message is present (*Fig. 10 and Fig. 11, col. 4 lines 1-3 and col. 8 lines 40-45; a notification message is sent to a terminal selected by the subscriber*).

Regarding claim 2, Smith teaches the method according to claim 1, which comprises, if a message service indicates the presence of a new message, storing with the notification server the data originating from the message service,

Art Unit: 2645

until the respective notification has been transmitted successfully(col.4 lines 50-56).

Regarding claim 3, Smith teaches the method according to claim 1, wherein the transmitting step comprises transmitting with the notification server the notification to all terminals of the subscriber(col.3 lines 50-54).

Regarding claim 4, Smith teaches the method according to claim 1, wherein the transmitting step comprises transmitting with the notification server the notification to at least one terminal selected by the subscriber from a plurality of terminals (col.10 lines 30-37).

Regarding claim 5, Smith teaches the method according to claim 4, wherein the subscriber selects the terminal by transmitting a control information item from the respective terminal to the notification server (col.10 lines 30-37).

Regarding claim 6, Smith teaches the method according to claim 1, which comprises transmitting with each message service a message header information item to the notification server when a new message is present, and transmitting the message header information with the notification server at least partially to the at least one terminal selected, at least partially, to output the message header information (col.8 lines 36-45).

Regarding claim 7, Smith teaches the method according to claim 1, which comprises, in response to a request by the notification server, transmitting with each message service a message header information item to the notification server, and transmitting at least partially the message header information item

Art Unit: 2645

with the notification server to the at least one terminal selected to output the message header information(col.8 lines 36-45).

Regarding claim 8, Smith teaches the method according to claim 1, which comprises, in response to a subscriber request from any terminal, firstly performing an authorization check with the notification server and then transmitting the notifications present to the terminal (col.10 lines 8-15 and lines 50-56).

Regarding claim 9, Smith teaches the method according to claim 1, which comprises processing with the notification server the data originating from the message services for generating the notifications transmitted to the subscriber(col.10 lines 5-10 and 18-25).

Regarding claim 10, Smith teaches the method according to claim 9, wherein the processing step comprises selecting one or more processes from the group consisting filtering, ordering, and formatting the data (col.10 lines 48-56; by pressing the "view" button, Smith filters, orders, and formats the data).

Regarding claim 11, Smith teaches the method according to claim 1, wherein the transmitting step comprises transmitting the notifications by means of a signaling operation to the at least one terminal of the subscriber (Fig.1-the signaling path from label 11 through 1800 to 1200).

Regarding claim 12, Smith teaches the method according to claim 1, wherein the transmitting step comprises transmitting the notifications by means of a call set-up to the at least one terminal of the subscriber (1300 Fig.1 and col.4 lines 15-24).

Art Unit: 2645

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 9:00-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax

Art Unit: 2645

phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTP  
July 9, 2004



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